APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,502	10/15/2001	Steven E. Berkheimer	BER6209P0012US	1487

32116	7590	10/13/2006

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EXAMINER
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ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 August 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date. _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Applicant' Remarks filed on August 04, 2006 in response to Examiner's Office Action

has been reviewed. Claims 1-28 are pending in this application. Claims 1, 10 and 20 are

independent claims. This action is Final.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

2.   Claims 1-7, 9-10 and 12-19 are rejected under 35 U.S.C. 102(b) as being anticipated by

U.S. Patent No. 5,671,353 to Tian et al.

Referring to claim 1, Tian discloses a method of archiving an item as claimed. See

Figures 2-14 and the corresponding portions of Tian's specification for this disclosure. Tian

teaches "a method of archiving an item [See Abstract, Background, Summary, and description of

PACS] comprising:

presenting the item [DICOM message] to a parser [See Column 5, lines 38-58];

parsing the item into a plurality of multi-part object structures [IODs (See Column 5,

lines 38-58 and Column 6, line 41 et seq.)] wherein portions of the structures have searchable

information tags associated therewith [See Column 8, line 43 et seq. and Column 14, line 57 et

seq.];

evaluating the object structures ['semantic validation'] in accordance with object

structures previously stored [rules] in an archive [See Column 5, lines 38-58 and all of

'Operational Scenarios' section beginning in Column 11];

presenting an evaluated object structure for manual reconciliation [See Column 10, lines

25-29] at least where there is a predetermined variance between the object and at least one of a

predetermined standard and a user defined rule [when a semantic warning is generated during

validation]" as claimed.

Referring to claim 2, Tian teaches the method of claim 1, as above, wherein the

respective structure can be manually edited [by the 'application developer'] after being presented

for reconciliation [See Column 10, lines 25-29] as claimed.

Referring to claim 3, Tian teaches the method of claim 1, as above, which includes,

before the parsing step, converting an input item [e.g. 'digitized medical imagery'] to a

standardized format [DICOM message format] for input to the parser [See Summary of the

Invention section] as claimed.

Referring to claim 4, Tian teaches the method of claim 1, as above, which includes

storing a reconciled object structure in the archive [See e.g. final paragraph of Summary of the

Invention] as claimed.

Referring to claim 5, Tian teaches the method of claim 4, as above, which includes

selectively editing an object structure [e.g. to correct the structure from a warning], linked to

other structures [via pointer or reference (See Columns 8-10)] to thereby effect a one-to-many

change in a plurality of archived items [via inheritance (See 'Operational Scenarios')] as

claimed.

Referring to claims 6 and 7, Tian teaches the method of claim 5, as above, which includes

compiling an item or a plurality of items [generation of a DICOM message to transmit

information to/from a PACS (See Summary and Column 4, line 58 – Column 5, line 5)] to be

output from the archive...[See above] as claimed.

Referring to claim 9, Tian teaches the method of claim 1, as above, which includes

forming object oriented data structures from the parsed items [See above] wherein the data

structures include [See Column 4, lines 20-40] at least some of item properties [modules], item

property values [attributes], element properties [elements (element descriptions)] and element

property values [element values] as claimed.

Claim 10 is rejected on substantially the same basis as claims 1-7 above. See the

discussions regarding claims 1-7 for the details of this disclosure. In particular, Tian teaches an

object-oriented archival system [See Fig. 1] comprising a storage medium [PACS storage] and a

set of executable instructions for establishing an archive...[See above] as claimed.

Claims 12-15 and 18 are rejected on substantially the same basis as claim 9, in light of

the basis for claim 10 above. See the discussions regarding claims 1-7, 9 and 10 for the details

of this disclosure.

Claims 16 and 17 are rejected on substantially the same basis as claim 5, in light of the

basis for claim 15. See the discussions regarding claims 1-7, 9 and 10 above for the details of

this disclosure.

Referring to claim 19, Tian teaches the method of claim 10, as above, wherein the output

file [DICOM message] comprises...an input for an electronic network [input to another PACS

system over a PACS network] as claimed.

Claim Rejections - 35 USC § 103

3.   Claims 8, 11 and 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Tian in view of U.S. Patent No. 6,456,395 to Ringness.

Referring first to claim 20, Tian discloses a method of generating layers corresponding to

separations in an object comprising:

establishing an archive [See Claims 1 and 10 above] populated with a plurality of object-

type structures wherein a first plurality of the structures represents a first layer [e.g. IOD layer],

wherein the members of the first plurality are linked to establish element definitions and

locations, relative to one another, in the first layer [See above], and, at least a second plurality of

the structures wherein the second plurality represents a second layer [e.g. block layer] wherein

the members of the second plurality are linked to establish element definitions and locations [See

above]…wherein the establishing step includes, analyzing the members of the first and second

pluralities for common structures [See Claims 1-7 and 9 above]…as claimed.

Tian's structures and layers do not correspond to color separations for a printing process,

wherein the first layer corresponds to a color separation for a multi-color output document and

the second layer corresponds to a second color separation for the output document as claimed.

However, Tian's documents [DICOM messages] are multi-color output documents in that they

include digital medical images. This provides suggestion for generating layers in the structured

environment to correspond to the colors in the document.

Ringness discloses a system and method similar to that of Tian, wherein object layers in a

multi-color document corresponding to different color separations for the document are extracted

for a printing process as claimed. See the Abstract, Summary, Figures 2-7 and the corresponding

portions of Ringness' specification for this disclosure.

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to add Ringness' method for separating colors into separate object structures for each

color layer to the method of Tian, so as to separate the colors within Tian's DICOM messages

for archival purposes, to obtain the invention as claimed. One would have been motivated to do

so because of Tian's suggestion as above, and to further meet Ringness' disclosed need (See

Column 2, lines 49-54) for more efficient methods of generating object structures for printing

purposes by expanding the method to other formats, such as the DICOM message used by the

medical community, to make printing the medical information in the DICOM message more

efficient.

Claims 21-23 are rejected on substantially the same basis as claim 1 above in light of the

basis for claim 20. See the discussions regarding claims 1 and 20 for the details of this

disclosure.

Claims 24-28 are rejected on substantially the same basis as claims 2-7, in light of the

basis for claims 20-23. See the discussions regarding claims 1-7 and 20-23 above for the details

of this disclosure.

Claims 8 and 11 are rejected on the same basis as claim 20, in light of the basis for claims

1 and 10 respectively. See the discussions regarding claims 1-7, 10 and 20 above for the details

of this disclosure.

Response to Arguments

4.   Applicant's arguments filed 13 February 2006 have been fully considered but they are not

persuasive.

Referring to applicant's remarks on pages 2-7 regarding the Section 102 rejections of the

independent claims: Applicant argued that Tian does not disclose a method of archiving an item.

The examiner disagrees for the following reasons: Applicant's characterization of Tian

as merely validating incoming and outgoing messages to ensure that they conform to a standard

ignores the fact that this validation occurs within a PACS system, as clearly indicated by Tian

throughout the specification. PACS stands for "Picture **Archival** and Communications System"

as described in Column 1, lines 15-45 of Tian's specification. (Emphasis added) Tian is directed

to the validation of DICOM messages that contain pictures, and to the archival thereof. Thus,

Tian is clearly directed to a method of archiving an item as claimed. Further, the examiner

submits that the only recitation of "archiving an item" occurs in the preamble of the claims,

which is not given patentable weight. A preamble is generally not accorded any patentable

weight where it merely recites the purpose of a process or the intended use of a structure, and

where the body of the claim does not depend on the preamble for completeness but, instead, the

process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190

USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA

1951). In the instant case, the preamble is considered an intended use because the body of the

claim does not depend on the preamble for completeness. Therefore, Tian does teach each and

every element of these claims.

Referring to applicant's remarks on pages 7-12 regarding the Section 102 rejections of the independent claims: Applicant argued that Tian's DICOM messages are not "items" as claimed and that Tian does not disclose or suggest parsing of any item.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., DICOM messages are not "items" and the "parsing" of the present invention is different than that of Tian) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, **limitations from the specification are not read into the claims**. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The remainder of applicant's remarks substantially repeat one or more of the above arguments or address features which are not claimed. The examiner's responses above apply here as well.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
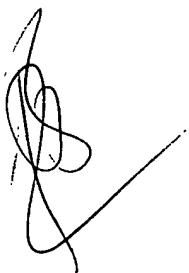
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 571-272-4020. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 10, 2006

THUY N. PARDO
PRIMARY EXAMINER